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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,246	03/06/2000	Stuart K. Williams	9896.143	8260

7590 05/24/2002

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EXAMINER

BARRETT, THOMAS C

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/519,246

Applicant(s)

WILLIAMS ET AL.

Examiner

Thomas C. Barrett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1, 11, 6-7, and 16-17 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that Paper No. 7 fails to provide: "reasons why the inventions *as claimed* are either independent or distinct, and reasons for insisting on restriction therebetween." This is not found persuasive because species are definitions of inventions; *claims are never species* (MPEP 806.04(e)). For example, a claim may include two or more of the disclosed embodiments (species) within the breadth and scope of the definition. Therefore, in a species restriction, there does not have to be "reasons why the inventions *as claimed* are either independent or distinct" because "*Claims are never species.*"

However, the Examiner has determined that claims 1-7, 9-17 and 19-21 also read on the elected collagen species, one of the different species of bioactive agents that have: (a) specific or (b) non-specific actions, either of which are divided into further sub-species, i.e. collagen, fibrinogen etc.

Claims 8 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Specification

The disclosure is objected to because the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper (p 15, lines 18-22). Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5, 7, 9-10, 12-15, 17, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 14 recite the limitation "the outer surface". There are insufficient antecedent basis for these limitations in the claims.

Claims 10 and 14 recite the limitation "the cover material". There are insufficient antecedent basis for these limitations in the claims.

Claim 10 also recites the limitation "the material". There is insufficient antecedent basis for this limitation in the claim.

Claims 4 and 14 also recite the limitation "the stent cover". There are insufficient antecedent basis for these limitations in the claims.

Claim 9 and 19 recite the limitation "the cover". There are insufficient antecedent basis for these limitations in the claims.

Regarding the phrase "a stent cover portion" used in claims 2-3 and 12-13, it is unclear whether a graft with a stent that has a portion meant for a cover is being claimed or a graft with a portion that covers a stent. That is why there is a 112 rejection because of a lack of antecedent basis in claims 4, 9, 14 and 19.

In claims 7 and 17, it is unclear what the phrase "including active portions and domains thereof" is modifying. Is it the group or just the von Willebrand factor?

Claims 2 and 12 are indefinite because the body of the claim claims elements that are not within the scope of the preamble. In drafting claims in accordance with 37 CFR 1.75(e), the preamble is to be considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination. The preambles of claims 2 and 12 do not positively and clearly include an "expandable portion" (stent).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 6-7, 9, 11-14, 16-17, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Turnlund et al. (6,292,603 B1). Turnlund et al. discloses an endovascular graft made of PET (col. 10, lines 5-11) that is coated with collagen (a bioactive agent) to promote thrombus formation (col. 9, lines 26-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4-5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnlund et al. (6,292,603 B1) in view of Clapper (5,744,515) as disclosed in the Applicant's IDS. Turnlund et al. discloses an endovascular graft that is coated with collagen however fails to disclose how the collagen is adhered to the graft. Clapper teaches the covalent bonding of collagen to a graft by the activation of photoreactive groups (col. 11, lines 1-22), to reduce possible patient reaction to other chemical residues, i.e. glutaraldehyde. It would have been obvious to one of ordinary skill in the art to combine the teaching of covalent bonding of collagen to a graft by the activation of photoreactive groups, as taught by Clapper, to an endovascular graft that is coated with collagen as per Turnlund et al. in order to reduce possible patient reaction to other chemical residues.

Conclusion

Please note: the Response to Request for Substitute Papers received on April 8, 2002 was 34 pages long, not 36 pages. The fax read "P. 034/034" however the cover page said there should have been 36 pages, including the cover page. Claim 21 and the abstract were not received.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

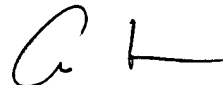
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3580 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0850.



Thomas Barrett
May 23, 2002



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700